



UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
 BOARD OF PATENT APPEALS AND INTERFERENCES
 BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Fred E. McKelvey
 Telephone: (703) 308-9797
 Facsimile: (703) 305-0942

MAILED

FEB 20 2002

PAT. & T.M. OFFICE
 BOARD OF PATENT APPEALS
 AND INTERFERENCES

Patentees: Stice et al.
 Application No.: 09/004,606
 Filed: 01/08/98, now U.S. Patent
 6,215,041 B1, granted 04/10/01
 For: Cloning using donor nuclei from
 a non-quiescent somatic cells

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 104,808.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

m9K

 Fred E. McKelvey
 Senior Administrative Patent Judge

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 1

Filed by: Fred E. McKelvey
Senior Administrative Patent Judge
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

Filed
20 February 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

NIKOLAI S. STRELCHENKO, JEFFREY M. BETTHAUSER,
GAIL L. JURGELLA, MARVIN M. PACE and MICHAEL D. BISHOP

MAILED

Junior Party,
(Application 09/357,445),

FEB 20 2002

v.

UNIVERSITY OF MASSACHUSETTS,
Senior Party
(Patents 5,945,577 and 6,215,041 and 6,235,696).

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Patent Interference 104,808 (McK)

NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties.

Details of the application, patents, counts and claims designated as corresponding or as not corresponding to the counts appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

Part B. Judge designated to handle the interference

Senior Administrative Patent Judge Fred E. McKelvey has been designated to handle the interference. 37 CFR § 1.610(a).

Part C. Standing order

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

Part D. Conference call to set dates

A telephone conference call to set dates for taking action in the interference is scheduled for 1:30 p.m. (Eastern Time) on 1 May 2002 (the call will be initiated from the PTO).

No later than 26 April 2002, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See § 17 of the STANDING ORDER.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE.

Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some mutual agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

Part E. The parties involved in this interference are:

Junior Party

Named inventors: Nikolai S. Strelchenko, WI
Jeffrey M. Betthauser, WI
Gail L. Jurgella, WI
Marvin M. Pace, WI
Michael D. Bishop, WI

Application: Application 09/357,445,
filed 20 July 1999

Title: Method of cloning animals

Assignee: Infigen, Inc.

Accorded Benefit: Application 09/239,922,
filed 28 January 1999,
now U.S. Patent 6,011,197,
granted 4 January 2000

Application 08/812,851,
filed 6 March 1997

Attorneys: See last page

Address: See last page

Senior Party

Named Inventors: Steven L. Stice, MA
Jose Cibelli, MA
James Robl, MA
Paul Golueke, MA
F. Abel Ponce de Leon, MA
D. Joseph Jerry, MA

Patent: U.S. Patent 5,945,577,
granted 31 August 1999,
based on application 08/781,752,
filed 10 January 1997

Title: Cloning using donor nuclei from
proliferating somatic cells

Assignee: University of Massachusetts

Accorded Benefit: None

Attorneys: See last page

Address: See last page

Senior Party

Named Inventors: Steven L. Stice, MA
Jose Cibelli, MA
James Robl, MA
Paul Golueke, MA
D. Joseph Jerry, MA

Patent: U.S. Patent 6,215,041 B1,
granted 10 April 2001,
based on application 09/004,606,
filed 8 January 1998 (37 CFR § 1.47)

Title: Cloning using donor nuclei from a non-quiescent somatic cells

Assignee: University of Massachusetts

Accorded Benefit: Application 08/888,057,
filed 3 July 1997,
U.S. Patent 6,235,969 B1,
granted 22 May 2001

Application 08/781,752,
filed 10 January 1997, now
U.S. Patent 5,945,577,
granted 31 August 1999

Attorneys: See last page

Address: See last page

Senior Party

Named Inventors: Steven L. Stice, MA
James Robl, MA
Jose Cibelli, MA
Paul Golueke, MA

Patent: U.S. Patent 6,235,969 B1,
granted 22 May 2001,
based on application 08/888,057,
filed 3 July 1997

Title: Cloning pigs using donor nuclei from
non-quiescent differentiated cells

Assignee: University of Massachusetts

Accorded Benefit: Application 08/781,752,
filed 10 January 1997, now
U.S. Patent 5,945,577,
granted 31 August 1999

Attorneys: See last page

Address: See last page

Part F. Count and claims of the parties

Count 1

A method according to either of claims 57 or 106 of Strelchenko application 09/357,445, wherein the ungulate animal is a bovine,

or

a method according to any of claims 1, 2, 3, 4, 5 or 6 of Stice patent 5,945,577, where the "non-human mammal" is a cow or a bovine and where the "non-human mammalian fetus" is a cow fetus or a bovine fetus,

or

a method according to any of claims 1, 19, 20, 21, 22 or 23, Stice patent 6,215,041, where the "non-human mammal" is a cow or a bovine and where the "non-human mammalian fetus" is a cow fetus or a bovine fetus

or

a method according to claim 24 of Stice patent 6,235,969 where the "non-human mammalian embryo" is a cow embryo or a bovine embryo.

The claims of the parties are:

Strelchenko: 57-58, 61-63, 69-88, 106, 112-115 and 118

Stice '577: 1-24

Stice '041: 1-23

Stice '969: 1-26

The claims of the parties which correspond to Count 1, and therefore are involved (35 U.S.C. § 135(a)) in the interference, are:

Strelchenko: 57-58, 61-63, 69-88, 106, 112-115 and 118

Stice '577: 1-24

Stice '041: 1-23

Stice '969: 24 and 26¹

The claims of the parties which do not correspond to Count 1, and therefore are not involved in the interference, are:

Strelchenko: None

Stice '577: None

Stice '041: None

Stice '969: 1-23 and 25

¹ It would appear, and therefore it has been assumed, that claims 25-26 should depend from claim 24, not claim 1. Stice may file a ~~file a~~ miscellaneous motion (37 CFR § 1.635) seeking entry of an order authorizing a certificate of correction to be issued which would correct the dependency of claims 25-26.

Count 2

A method according to either of claims 57 or 106 of Strelchenko application 09/357,445, wherein the ungulate animal is an ovine,

or

a method according to any of claims 1, 2, 3, 4, 5 or 6 of Stice patent 5,945,577, where the "non-human mammal" is a sheep or an ovine and where the "non-human mammalian fetus" is a sheep fetus or an ovine fetus,

or

a method according to any of claims 1, 19, 20, 21, 22 or 23, where the "non-human mammal" is a sheep or an ovine and where the "non-human mammalian fetus" is a sheep fetus or an ovine fetus,

or

a method according to claim 24 of Stice patent 6,235,969 where the "non-human mammalian embryo" is a sheep embryo or an ovine embryo.

The claims of the parties are:

Strelchenko: 57-58, 61-63, 69-88, 106, 112-115 and 118

Stice '577: 1-24

Stice '041: 1-23

Stice '969: 1-26

The claims of the parties which correspond to Count 2, and therefore are involved (35 U.S.C. § 135(a)) in the interference, are:

Strelchenko: 57-58, 61-63, 69-88, 106, 112-115 and 118

Stice '577: 1-22

Stice '041: 1-23

Stice '969: 24 and 26

The claims of the parties which do not correspond to Count 2, and therefore are not involved in the interference, are:

Strelchenko: None

Stice '577: 23-24

Stice '041: None

Stice '969: 1-23 and 25

Count 3

A method according to either of claims 57 or 106 of Strelchenko application 09/357,445, wherein the ungulate animal is an equine,

or

a method according to any of claims 1, 2, 3, 4, 5 or 6 of Stice patent 5,945,577, where the "non-human mammal" is a horse or an equine and where the "non-human mammalian fetus" is a horse fetus or an equine fetus,

or

a method according to any of claims 1, 19, 20, 21, 22 or 23, of Stice patent 6,215,041 where the "non-human mammal" is a horse or an equine and where the "non-human mammalian fetus" is a horse fetus or an equine fetus,

or

a method according to claim 24 of Stice patent 6,235,969 where the "non-human mammalian embryo" is a horse embryo or an equine embryo.

The claims of the parties are:

Strelchenko: 57-58, 61-63, 69-88, 106, 112-115 and 118

Stice '577: 1-24

Stice '041: 1-23

Stice '969: 1-26

The claims of the parties which correspond to Count 3, and therefore are involved (35 U.S.C. § 135(a)) in the interference, are:

Strelchenko: 57-58, 61-63, 69-88, 106, 112-115 and 118

Stice '577: 1-22

Stice '041: 1-23

Stice '969: 24 and 26

The claims of the parties which do not correspond to Count 3, and therefore are not involved in the interference, are:

Strelchenko: None

Stice '577: 23-24

Stice '041: None

Stice '969: 1-23 and 25

Count 4

A method according to either of claims 57 or 106 of Strelchenko application 09/357,445, wherein the ungulate animal is a porcine,

or

a method according to any of claims 1, 2, 3, 4, 5 or 6 of Stice patent 5,945,577, where the "non-human mammal" is a pig or a porcine and where the "non-human mammalian fetus" is a pig fetus or a porcine fetus,

or

a method according to any of claims 1, 19, 20, 21, 22 or 23, of Stice patent 6,215,041 where the "non-human mammal" is a pig or a porcine and where the "non-human mammalian fetus" is a pig fetus or a porcine fetus,

or

a method according to any of claims 1 or 20 of Stice patent 6,235,969 or claim 24 of Stice patent 6,235,969 where the "non-human mammalian embryo" is a pig embryo or a porcine embryo.

The claims of the parties are:

Strelchenko: 57-58, 61-63, 69-88, 106, 112-115 and 118

Stice '577: 1-24

Stice '041: 1-23

Stice '969: 1-26

The claims of the parties which correspond to Count 4, and therefore are involved (35 U.S.C. § 135(a))⁶ in the interference, are:

Strelchenko: 57-58, 61-63, 69-88, 106, 112-115 and 118

Stice '577: 1-22

Stice '041: 1-23

Stice '969: 1-26

The claims of the parties which do not correspond to Count 4, and therefore are not involved in the interference, are:

Strelchenko: None

Stice '577: 23-24

Stice '041: None

Stice '969: None

Part G. Heading to be used on papers

The following heading shall be used on papers filed in the interference. See § 18 of the STANDING ORDER.

Paper ²

Filed on behalf of [name of party]
By: Name of lead counsel, Esq.
Name of backup counsel, Esq.
Street address
City, State, and Zip-Code
Tel:
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

NIKOLAI S. STRELCHENKO, JEFFREY M. BETTHAUSER,
GAIL L. JURGELLA, MARVIN M. PACE and MICHAEL D. BISHOP,

Junior Party,
(Application 09/357,445),

v.

UNIVERSITY OF MASSACHUSETTS,

Senior Party
(Patents 5,945,577 and 6,215,041 and 6,235,696).

Patent Interference 104,808 (McK)

TITLE OF PAPER

² Leave a blank line because the board assigns the paper number.

Part H. Summary of dates for taking action

Times for taking action are set out in the following sections of the STANDING ORDER:

1. **§ 7**: date for identifying lead and backup counsel.
2. **§ 8**: date for identifying any real party in interest.
3. **§ 9**: date for requesting copies of involved and benefit applications and patents.
4. **§ 17**: date for filing list of proposed preliminary motions.
5. **§ 19**: date for accomplishing certain discovery.
6. **§ 20**: date for filing clean copy of claims.
7. **§ 21**: date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
8. **§ 23**: dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
9. **§ 33**: date for objecting to admissibility of evidence.
10. **§ 34**: date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
11. **§ 35**: dates when cross-examination can take place.
12. **§ 45**: dates for taking action with respect to settlement discussions

Part I. Order form for requesting file copies

FILE COPY REQUEST

Interference 104,808 (McK)

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. _____
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

Telephone, including area code: _____

Part J. Signature of administrative patent judge

mck

Fred E. McKelvey
Senior Administrative Patent Judge

20 February 2002
Arlington, VA

Enc:

Copy of STANDING ORDER

Copy of order used for setting times for taking action in
the preliminary motion phase of the interference (ORDERPM6)

Copy of order used for setting times for taking action in
the testimony and briefing phases of the interference
(ORDERTE6)

PTO Form 850 (3 pages)

Copy U.S. Patents 5,945,577
6,011,197
6,215,041
6,235,969

Copy of Strelchenko claims

Copy PALM bibliographic data for Strelchenko application

DECLARE.007

Revised September, 2000
(replaces DECLARE.006.1)

cc (via Federal Express):

Attorney for Strelchenko
(real party in interest
Infigen, Inc.):

FOLEY & LARDNER
402 West Broadway
23rd Floor
San Diego, CA 92101

Tel: None
Fax: None
E-mail: None

Attorney for University of Massachusetts
(Licensee: Advanced Cell Technology Corporation;
Inventors: Steven L. Stice, Jose Cibelli, James Robl,
Paul Golueke, F. Abel Ponce de Leon and D. Joseph Jerry)

E. Anthony Figg, Esq.
ROTHWELL FIGG ERNST & MANBECK, PC
555 Thirteenth Street, NW
Washington, D.C. 20004

Tel: 202-783-6040
Fax: 202-783-6031
E-mail: None

Robin L. Teskin, Esq.
PILLSBURY WINTHROP, L.L.P.
1600 Tysons Boulevard
McLean, VA 22102

Tel: 703-905-2200
Fax: 703-905-2500
E-mail: None